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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,673	12/30/2003	Hiroyuki Egami	122.1575	2908
21171 7590 01/14/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER WALSH, DANIEL I	
			ART UNIT 2887	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/747,673

Applicant(s)

EGAMI ET AL.

Examiner

Daniel I. Walsh

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8-26-07, 7-19-07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Receipt is acknowledged of the amendment received on 10-29-07.

The indicated allowability of claims is withdrawn in view of reconsideration of the Oda et al. and Fujioka (new) references. Any delay is regretted.

#### ***Claim Objections***

2. Claims 4 and 10 are objected to because of the following informalities:

Claim 10 refers to itself, and not another claim. Appropriate correction is required. For purposes of Examination, the Examiner will interpret claim 10 to depend on claim 3.

Re claims 4 and 10: Replace "without insertion of a hand into the bill receptacle being detected by said sensors" with – without the sensors in the receptacle having been triggered. --  
The Examiner notes this is to preclude something besides a hand being inserted.

Appropriate clarification/correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 4-8, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oda et al. (US 6,731,778) in view of Fujioka (US 7,014,105).

Oda et al. teaches an ATM with a bill receptacle and a security camera that captures an image when one accesses the receptacle (FIG. 2).

Though silent to the camera being in the receptacle, Oda et al. teaches that a photograph of the users hand when entering the receptacle is recorded (FIG.34-35). Oda et al. teaches a camera 217 for photographing a face and a camera 218 to photograph a hand. Though Oda et al. does not teach the camera for the hand is in the receptacle, the Examiner notes that it would have been obvious to have the camera at the location of the image capture (inside the receptacle) in order to be closer to the object being captured in order to capture a better/closer image, and ensuring that the object is captured and not obstructed, which could occur if the camera is placed higher up on the ATM such as Oda et al. teaches. Though Oda et al. teaches that the camera used to capture the hand in the receptacle also teaches capturing of the hand pressing the buttons, and insertion of the card by hand, the Examiner notes it would have been obvious to have a separate camera for at least the receptacle, to ensure that a quality and focused image of the hand (subject) in the receptacle is captured. Having separate image cameras ensures that even if one camera is not functioning properly, that the other cameras can capture images, and having a

separate camera in the receptacle ensures that a greater range is covered; the angle B of FIG. 34 appears to not completely capture the receptacle area, and by providing a camera in the receptacle, more of the receptacle could be captured, increasing the sum of areas/ranges covered by the cameras and ensuring that the desired hand is captured). The mere duplication of essential working parts of a device involves only routing skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Further, motivation is provided as Oda et al. teaches that conventional photographing apparatus, a separate camera is required for the different sites of the body (col 1, lines 27+). Therefore, having a separate camera at least for the receptacle is an obvious expedient to ensure that image capture occurs close to the subject (hand) which reduces the chance of the image being obstructed by the user, can provide a closer photograph, and can also provide separate means which is beneficial if the other cameras are not functioning properly. Though silent to a shutter, shutters for bill receptacles are an obvious expedient for security and keeping out debris/weather/etc., and have been discussed in the previous Office Action. The camera captures images of the hand taking out/depositing bills, which occurs when the shutter is opened (access provided).

Fujioka teaches a shutter 6.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Oda et al. with those of Fujioka.

One would have been motivated to do this for protection/security/safety.

Re claims 2-3, Oda et al. teaches a sensor 46 for detecting hand insertion into the receptacle to capture the image (whether to deposit or withdraw bills). Though silent to more than one sensor, the mere duplication of parts is obvious to one of ordinary skill in the art, and

the expected result of more precise/accurate/more fail safe detection can be obtained with multiple sensors.

Re claim 4 and 9, the Examiner notes that Oda et al. teaches that the CPU starts monitoring a time when the operation is completed (such as when the card/coin/banknote/currency/etc. is no longer detected by a sensor, takes images, and if the images show that the user is not present, the transaction is cancelled and takes in the card, currency, bankbook, etc. (col 30, lines 28+). This is done for security purposes, for if someone forgets to remove currency/their card, etc., the machine takes pictures and cancels the transaction and takes back into it, the card/cash/money, etc. Though silent to doing this when the shutter is opened and the money is not taken out, the Examiner notes that a shutter has been discussed as an obvious expedient to provide security/protection. Therefore, the Examiner believes, that in light of the teachings above where the card, bankbook, bank note, coins, etc. are taken back into the machine when a user is not detected after a predetermined time, it would have been obvious to do so when the shutter is opened and the money is not taken out, in order to provide security in instances when a user forgets to remove the currency.

Re claims 5-8 and 10-15, Oda et al. teaches separate security cameras 217 and 218, and as discussed above, a separate camera in the receptacle as well. The Examiner notes that the cameras 217 and 218 capture non-overlapping ranges/independent images, as one captures facial images, the other captures hand images. Further, as discussed above, insertion of a camera into the receptacle to capture hand entry in there would also be interpreted as an independent image/non overlapping.

Re claim 16, the limitation shave been discussed above re claim 1.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel I Walsh  
Examiner  
Art Unit 2887

